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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/729,113
Filing Date	December 5, 2003
First Named Inventor	Jeffery R. Parker
Art Unit	2875
Examiner Name	Ismael Negron
Attorney Docket Number	GLOLP0114USA

ENCLOSURES *(Check all that apply)*

- [✔] Fee Transmittal Form
- [✔] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
  - [ ] Landscape Table on CD
- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [✔] Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- [ ] Proprietary Information
- [ ] Status Letter
- [✔] Other Enclosure(s) (please Identify below):

Credit Card Payment Form
PTO-2038

Brief is filed in triplicate.

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Renner, Otto, Boisselle & Sklar, LLP		
Signature			
Printed name	Donald L. Otto		
Date	December 12, 2005	Reg. No.	22,125

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Donald L. Otto	Date	December 12, 2005

PTO/SB/17 (12-04)
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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) $500.00

Complete if Known	
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First Named Inventor	Jeffery R. Parker
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Art Unit	2875
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METHOD OF PAYMENT (check all that apply)

☐ Check ☑ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☑ Deposit Account Deposit Account Number: 18-0988 Deposit Account Name: Renner Otto Boisselle & Sklar LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	FILING FEES Small Entity Fee ($)	SEARCH FEES Fee ($)	SEARCH FEES Small Entity Fee ($)	EXAMINATION FEES Fee ($)	EXAMINATION FEES Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 20 or HP =	_____	x _____	= _____

HP = highest number of total claims paid for, if greater than 20

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	_____	x _____	= _____

HP = highest number of independent claims paid for, if greater than 3

Multiple Dependent Claims Fee ($)	Fee Paid ($)
_____	_____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
_____ - 100 =	_____ / 50 =	_____ (round **up** to a whole number) x	_____	= _____

4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	
Other: Appellants' Brief (in triplicate)	$500.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 22,125	Telephone 216-621-1113
Name (Print/Type)	Donald L. Otto		Date December 12, 2005

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: December 12, 2005

Donald L. Otto

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket GLOLP0114USA

In re PATENT application of

Jeffery R. Parker et al

Serial No. 10/729,113

Filed December 5, 2003

For: METHOD OF SELECTING A LIGHT REDIRECTING FILM

Art Unit 2875/Confirmation No. 3167
Ismael Negron, Examiner

APPELLANTS' BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the decision of the Examiner mailed August 10, 2005 finally rejecting all of the pending claims 1-37. An Appendix containing a copy of the claims on appeal is attached hereto.

(1) REAL PARTY IN INTEREST

The real party in interest is Solid State Opto Limited, the assignee of the entire right, title and interest in and to the above application.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences which directly affect or have any bearing on the Board's decision in the pending appeal.

(3) STATUS OF CLAIMS

This appeal is taken on all of the pending claims 1-37.

(4) STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection of August 10, 2005.

(5) SUMMARY OF INVENTION

The invention toward which the appealed claims are directed relates to a method of selecting a light redirecting film or optical panel including the steps of providing a length of film or substrate having a pattern 40 of individual optical elements 5^{XVII} that varies, selecting an area of the pattern that best suits a particular application, and removing the selected area from the film or substrate to provide the light redirecting film or optical panel as shown in Fig. 15 of the drawings and described on page 14, lines 15-19 of the specification as amended. The length of film or substrate comprises a roll 41 of the film or substrate which may have a repeating pattern of the optical elements thereon that are quite small in relation to the width and length of the film or substrate and may vary in slope angle, density, position, orientation, height or depth, shape and/or size at different locations on the film or substrate as shown in Figs. 7, 8, 10, 13 and 14 and described on page 11, lines 27-32 of the amended specification.

Alternatively, the individual optical elements may be randomized on the film or substrate as schematically shown in Figs. 16 and 17. Also, at least some of the individual optical elements may be arranged in groupings 32, 32' and 32" across the film or substrate, with at least some of the optical elements in each grouping having a different size or shape characteristic that collectively produce an average size or shape characteristic for each of the groupings that varies across the film or substrate as schematically shown in Figs. 7, 13 and 15 and described on page 12, lines 1-20 of the amended specification. Moreover, at least some of the optical elements may overlap each other as shown in Figs. 6, 7, 13 and 15 or intersect each other as shown in Figs. 8-10 or interlock each other as shown in Figs. 11 and 12 and described on page 11, lines 1-9 of the amended specification.

(6) ISSUES

The following issues are presented for review on appeal:

A. Whether claims 1, 2, 10, 12-15, 18-21, 29, 30, 32-34 and 37 are anticipated by Ashall (U.S. Patent 5,390,436) under 35 U.S.C. § 102(b) or, in the alternative, obvious over Ashall under 35 U.S.C. § 103(a).

B. Whether claims 10, 16, 30 and 35 are anticipated by Parker et al (U.S. Patent 5,618,096) under 35 U.S.C. § 102(b), or in the alternative, obvious over Parker et al under 35 U.S.C. § 103(a).

C. Whether claims 3, 4, 7, 11, 17, 22, 23, 26, 31 and 36 are unpatentable over Ashall (U.S. Patent 5,390,436) in view of Mizobe (U.S. Patent 5,641,219) under 35 U.S.C. § 103(a).

D. Whether claims 5, 6, 8, 9, 24, 25, 27 and 28 are unpatentable over Ashall (U.S. Patent 5,390,436) under 35 U.S.C. § 103(a).

(7) GROUPING OF CLAIMS

For the reasons set forth in the argument which follows, not all of the rejected claims as grouped by the Examiner stand or fall together.

(8) ARGUMENT

Appellants' contentions with respect to the issues presented for review, and the basis therefor, are set forth below.

A. The rejection of claims 1, 2, 10, 12-15, 18-21, 29, 30, 32-34 and 37

Claims 1, 2, 10, 12-15, 18-21, 29, 30, 32-34 and 37 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Ashall.

The Examiner acknowledges that Ashall fails to disclose the claimed method of selecting a light redirecting film (or optical panel), but contends it would have been obvious that the claimed method of selecting a light redirecting film was inherently disclosed by the structural limitations of the illumination device of Ashall. Alternatively, the Examiner contends that even if the particular method presented by the claims is not considered as inherently disclosed by the structure of Ashall, such method would have been considered an obvious matter of design choice as required by the specific requirements of a particular application, allegedly because the method has no impact on the final structure or characteristics of the claims' optical film. According to the Examiner, support for such finding of non-criticality of the method is found in the

appellants' own description which the Examiner states is silent as to the advantages of one method over another and makes no mention at all of a particular method of selecting the light redirecting film.

However, this is clearly not the case, in that page 14, lines 6-10 of the specification as filed (and page 14, lines 15-19 of the specification as amended) specifically discloses that where the light redirecting film has a pattern of optical elements thereon that varies along the length of the film, a roll of the film may be provided having a repeating pattern of optical elements thereon as schematically shown in Fig. 15 to permit a selected area of the pattern that best suits a particular application to be die cut from the roll of film. Moreover, it is respectfully submitted that nowhere does Ashall disclose or suggest the method of selecting a light redirecting film or optical panel for a particular application including the steps of providing a length of film or substrate having a pattern of optical elements on or in the film or substrate that varies, selecting an area of the pattern that best suits a particular application, and removing the selected area from the film or substrate to provide the light redirecting film or optical panel as recited in these claims.

The Examiner concedes in the first paragraph on page 11 of the final rejection and elsewhere that no method of selecting such film is explicitly discussed in Ashall. Nevertheless, the Examiner argues that one of ordinary skill in the art would have recognized that before providing the film to the panel of Ashall one would have to select the appropriate film 13 before applying it to the panel 10. However, the only disclosure in Ashall regarding using a film is column 2, lines 37-40, which states that the matrix of dots may be applied to a transparent film which then may be adhered to the transparent

sheet. This is entirely different than providing a length of film or substrate having a pattern of optical elements on or in the film or substrate that varies, selecting an area of the pattern on the length of film or substrate that best suits a particular application, and then removing the selected area from the length of film or substrate to provide the light redirecting film or optical panel as claimed. Thus it is submitted that the Examiner has made a modification to Ashall which is not suggested by anything other than appellants' own disclosure. This is hindsight reconstruction, which is clearly improper.

Also, while Ashall discloses that the dots can be of any shape, for example square, round, rectangular, triangular or of irregular shape (column 2, lines 27-29), there is no disclosure or suggestion in Ashall of providing a length of film or substrate having a pattern of optical elements on or in the length of film or substrate that varies, wherein at least some of the optical elements have different shapes as recited in claims 14 and 33, or wherein at least some of the optical elements have a different beam profile at different locations on the length of film as recited in claims 15 and 34. Nor does Ashall disclose or suggest providing such a length of film or substrate having a pattern of optical elements that varies, wherein at least some of the optical elements are arranged in groupings across the length of film, with at least some of the optical elements in at least some of the groupings having a different size or shape characteristic that collectively produce an average size or shape characteristic for each of the groupings that varies across the length of film as recited in claim 19.

Accordingly, claims 1, 2, 10, 12-15, 18-21, 29, 30, 32-34 and 37 are submitted as clearly allowable over Ashall.

B. The rejection of claims 10, 16, 30 and 35

Claims 10, 16, 30 and 35 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Parker et al.

The Examiner acknowledges that Parker et al fails to disclose the claimed method for selecting a light redirecting film (or optical panel), but contends it would have been obvious that the claimed method of selecting a light redirecting film was inherently disclosed by the structural limitations of the illumination device of Parker et al. Alternatively, the Examiner contends that even if the particular method presented by the claims is not considered as inherently disclosed by the patented structure of Parker et al, such method would have been considered an obvious matter of design choice as required by the specific requirements of a particular application, such method having no impact on the final structure or characteristics of the claims' optical film. According to the Examiner, support for such finding of non-criticality of the method is found in the applicants' own description which is silent as to the advantages of one method over another. Also according to the Examiner, applicants' disclosure is directed to the structure, and makes no mention at all of a particular method of selecting a light redirecting film.

However, as pointed out previously, page 14, lines 6-10 of applicants' specification as filed clearly discloses the claimed method of selecting a light redirecting film or optical panel for a particular application. Moreover, while Parker et al admittedly disclose a light redirecting film having a plurality of optical elements disposed in a pattern on the film that are small in relation to the size of the film, and may be randomly distributed on the film, nowhere does Parker et al disclose or suggest the claimed

method of selecting a light redirecting film or optical panel for a particular application including the steps of providing a length of film or substrate having a pattern of such individual optical elements that varies, selecting an area of the length of film or substrate that has a pattern of the optical elements that best suits a particular application, and removing the selected area from the length of film or substrate to provide the light redirecting film or optical panel. Thus here again, it is respectfully submitted that the Examiner has modified Parker et al in light of applicants' own disclosure and certainly not from any teachings or suggestions found in Parker et al, which is clearly improper. Accordingly, claims 10, 16, 30 and 35 are submitted as clearly allowable over Parker et al.

C. The rejection of claims 3, 4, 7, 11, 17, 22, 23, 26, 31 and 36

Claims 3, 4, 7, 11, 17, 22, 23, 26, 31 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ashall in view of Mizobe.

The Examiner acknowledges that Ashall does not disclose or suggest the pattern (of optical elements) varying along the width of the film (as recited in claims 3 and 22); the pattern varying along both the length and width of the film (as recited in claims 4 and 23); the pattern being a repeating pattern on the film (as recited in claims 7, 11, 26 and 31); and at least some of the optical elements being oriented at different angles on the film (as recited in claims 17 and 36).

As to some of these claim features, the Examiner contends it would have been obvious to vary the pattern of Ashall along the width of the film (as recited in claims 3 and 22), or both the length and width of the film (as recited in claims 4 and 23) to compensate for the distribution of light across the surface of the light source and further

increase the uniformity of the light produced by the film, as per the teachings of Mizobe (column 4, lines 24-40). Also according to the Examiner, it would have been obvious to orient at least some of the optical elements of Ashall at different angles on the film (as recited in claims 17 and 36) to compensate for the angular displacement as well as the longitudinal displacement of the optical elements with respect to the location of the light source, to further increase the uniformity of the light produced by the film, as per the teachings of Mizobe (column 4, lines 59-65).

However, nowhere does Mizobe disclose or suggest varying the pattern along a length of film as recited in claims 3 and 22 or along both the width and length of the film as recited in claims 4 and 23, or of orienting at least some of the optical elements at different angles on the length of film as recited in claims 17 and 36 and then selecting an area of the pattern that best suits a particular application and removing the selected area from the length of film to provide a light redirecting film or optical panel as recited in these claims. Moreover, nowhere does Mizobe disclose or suggest providing a repeating pattern on a length of film or substrate from which an area of the film or substrate that has a pattern of the optical elements that best suits a particular application is selected and removed from the film or substrate to provide a light redirecting film or optical panel as recited in claims 7, 11, 26 and 31. Accordingly, claims 3, 4, 7, 11, 17, 22, 23, 26, 31 and 36 are submitted as clearly allowable over Ashall in view of Mizobe.

D. The rejection of claims 5,6, 8, 9, 24, 25, 27 and 28

Claims 5, 6, 8, 9, 24, 25, 27 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ashall.

The Examiner acknowledges that Ashall does not disclose the film being formed in a roll (as recited in claims 5, 8, 24 and 27); the selected area being removed from the film roll (as recited in claims 5, 8, 24 and 27); and the selected area being die-cut from the length of the film (as recited in claims 6, 9, 25 and 28). Nevertheless, the Examiner contends it would have been obvious to form the film in a roll (as recited in claims 5, 8, 24 and 27) with the selected area being removed from such film roll (as recited in claims 5, 8, 24 and 27) by die-cutting (as recited in claims 6, 9, 25 and 28).

In support, the Examiner contends that such method of forming and cutting films is not only old and well known, but standard in the art, and that one would have been motivated to be able to form such film in a continuous strip easy to store and transport, and from which strip desired shapes and sizes could be cut as required by a particular application. However, it is respectfully submitted that it is not old and well known or standard in the art to make light redirecting films or optical panels from a roll of film or substrate having a pattern of optical elements thereon that varies, and selecting and removing an area of the pattern on the film or substrate roll that suits a particular application to provide a light redirecting film or optical panel as recited in these claims. In fact, the only motivation for making these modifications to Ashall is appellants' own disclosure. This is hindsight reconstruction and does not establish obviousness under 35 U.S.C. § 103(a). Accordingly, claims 5, 6, 8, 9, 24, 25, 27 and 28 are submitted as clearly allowable over Ashall.

CONCLUSION

For the reasons set forth above, appellants respectfully request that the rejection of claims 1-37 on appeal be reversed and that such claims be allowed.

The Brief is filed herewith in triplicate, and a credit card payment (Form PTO-2038) in the amount of $500.00 is enclosed to cover the costs associated with its filing.

In the event that an extension of time is necessary, this should be considered to be a petition for such an extension. If required, fees are enclosed for the extension of time. In the event any additional fees are due in connection with the filing of this Brief, the Commissioner is hereby authorized to charge those fees to our Deposit Account No. 18-0988 (Attorney Docket GLOLP0114USA).

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By _____
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CLAIMS APPENDIX

1. A method of selecting a light redirecting film for a particular application comprising the steps of providing a length of film having a pattern of optical elements on or in the film that varies, selecting an area of the pattern that best suits a particular application, and removing the selected area from the film to provide the light redirecting film.

2. The method of claim 1 wherein the pattern varies along the length of the film.

3. The method of claim 1 wherein the pattern varies along the width of the film.

4. The method of claim 1 wherein the pattern varies along the length and width of the film.

5. The method of claim 1 wherein the length of the film comprises a roll of the film from which the selected area is removed.

6. The method of claim 1 wherein the selected area is die cut from the length of the film.

7. The method of claim 1 wherein the pattern is a repeating pattern on the film.

8. The method of claim 7 wherein the length of the film comprises a roll of the film from which the selected area is removed.

9. The method of claim 8 wherein the selected area is die cut from the roll of the film.

10. A method of selecting a light redirecting film for a particular application comprising the steps of providing a length of film having a pattern of individual optical elements of well defined shape on or in the film that varies, the optical elements being quite small in relation to a width and length of the film, selecting an area of the film that has a pattern of the optical elements that best suits a particular application, and removing the selected area from the film to provide the light redirecting film.

11. The method of claim 10 wherein the pattern is a repeating pattern.

12. The method of claim 10 wherein the pattern varies at different locations on the film.

13. The method of claim 10 wherein at least some of the optical elements overlap, intersect or interlock each other.

14. The method of claim 10 wherein at least some of the optical elements have different shapes.

15. The method of claim 10 wherein at least some of the optical elements have a different beam profile at different locations on the film.

16. The method of claim 10 wherein at least some of the optical elements are randomly distributed on the film.

17. The method of claim 10 wherein at least some of the optical elements are oriented at different angles on the film.

18. The method of claim 10 wherein at least some of the optical elements vary in at least one of the following characteristics: slope angle, density, position, orientation, height or depth, shape, and size.

19. The method of claim 10 wherein at least some of the optical elements are arranged in groupings across the film, with at least some of the optical elements in at least some of the groupings having a different size or shape characteristic that collectively produce an average size or shape characteristic for each of the groupings that varies across the film.

20. A method of selecting an optical panel for a particular application comprising the steps of providing a length of substrate having a pattern of optical elements on or in the substrate that varies, selecting an area of the pattern that best suits a particular

application, and removing the selected area from the substrate to provide the optical panel.

21. The method of claim 20 wherein the pattern varies along the length of the substrate.

22. The method of claim 20 wherein the pattern varies along the width of the substrate.

23. The method of claim 20 wherein the pattern varies along the length and width of the substrate.

24. The pattern of claim 20 wherein the length of the substrate comprises a roll of the substrate from which the selected area is removed.

25. The method of claim 20 wherein the selected area is die cut from the length of the substrate.

26. The method of claim 20 wherein the pattern is a repeating pattern on the substrate.

27. The method of claim 26 wherein the length of the substrate comprises a roll of the substrate from which the selected area is removed.

28. The method of claim 27 wherein the selected area is die cut from the roll of the substrate.

29. The method of claim 20 wherein the optical panel is a backlight.

30. A method of selecting an optical panel for a particular application comprising the steps of providing a length of substrate having a pattern of individual optical elements of well defined shape on or in the substrate that varies, the optical elements being quite small in relation to a width and length of the substrate, selecting an area of the substrate that has a pattern of the optical elements that best suits a particular application, and removing the selected area from the substrate to provide the optical panel.

31. The method of claim 30 wherein the pattern is a repeating pattern.

32. The method of claim 30 wherein the pattern varies at different locations on the substrate.

33. The method of claim 30 wherein at least some of the optical elements have different shapes.

34. The method of claim 30 wherein at least some of the optical elements have a different beam profile at different locations on the film.

35. The method of claim 30 wherein at least some of the optical elements are randomly distributed on the film.

36. The method of claim 30 wherein at least some of the optical elements are oriented at different angles on the film.

37. The method of claim 30 wherein at least some of the optical elements vary in at least one of the following characteristics: slope angle, density, position, orientation, height or depth, shape and size.

EVIDENCE APPENDIX

There is no evidence to be considered under this heading.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to be considered under this heading.

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